

**REMARKS UNDER 37 CFR § 1.111**

**Formal Matters**

Claims 1, 12-13, 46, 53, 58, 190-192 and 194-217 are pending after entry of the amendments set forth herein.

Claims 1, 12-13, 46, 53, 58, 190-192 and 194-216 were examined. Claims 1, 12-13, 46, 53, 58, 190-192 and 194-216 were rejected.

Applicants respectfully request reconsideration of the application in view of the amendments and remarks made herein.

No new matter has been added.

**The Office Action**

**Claims Rejected Under Nonstatutory Double Patenting (U.S. Patent No. 6,743,169)**

In the Official Action of October 4, 2007, claims 1, 12-13, 53, 58, 190-192, 194-214 and 216 were rejected on the ground of nonstatutory double patenting over claims 1-4, 6-13, 17, 20-26, and 31-32 of U.S. Patent No. 6,743,169, since the Examiner considered the currently claimed subject matter to be fully disclosed in the patent and covered by the patent since both the application and patent are claiming common subject matter, and the difference between the application claims and the patent claims is that the patent claims include more elements and are thus more specific.

Although Applicants do not agree with this ground of rejection and do not acquiesce thereto, Applicants respectfully submit that a terminal disclaimer disclaiming any period of protection that may otherwise extend beyond the patent period of U.S. Patent No. 6,743,169 was submitted along with the amendment filed on December 19, 2006 in this case, in response to the Final Office Action dated October 10, 2006.

The Examiner has asserted that the above terminal disclaimer was not received. Accordingly, Applicants are submitting, concurrently with this response, a copy of the terminal disclaimer that was filed on December 19, 2006, together with a copy of the Officially-stamped postcard indicating that the terminal disclaimer was received by the Patent Office on December 22, 2006. Since the terminal

disclaimer fee was also paid at that time, the Examiner is requested to insure that Applicants are not charged again for submission of this copy of the previously filed terminal disclaimer.

In view of the above comments and the terminal disclaimer which has already been filed, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 1, 12-13, 53, 58, 190-192, 194-214 and 216 on the ground of nonstatutory double patenting over claims 1-4, 6-13, 17, 20-26, and 31-32 of U.S. Patent No. 6,743,169 as being moot.

**Claim Rejected Under Nonstatutory Obviousness-Type Double Patenting (U.S. Patent No. 6,743,169 in view of Vierra et al.)**

Claim 46 was rejected on the ground of nonstatutory obviousness-type double patenting over claim 1 of U.S. Patent No. 6,743,169 in view of Vierra et al., U.S. Patent No. 5,749,892.

For at least the reasons provided above, Applicants do not agree with this ground of rejection and do not acquiesce thereto.

In view of the above comments and the terminal disclaimer which has already been filed, the Examiner is respectfully requested to reconsider and withdraw the rejection of claim 46 on the ground of nonstatutory obviousness-type double patenting over claim 1 of U.S. Patent No. 6,743,169 in view of Vierra et al., U.S. Patent No. 5,749,892, as being moot.

**Claim Rejected Under 35 U.S.C. Section 102(b) (DelRossi et al.)**

Claim 216 was rejected under 35 U.S.C. Section 102(b) as being anticipated by DelRossi et al., "A New Retractor to Aid in Coronary Artery Surgery". The Examiner asserted that DelRossi et al. discloses a device for use in cardiovascular surgery comprising a shaft member and at least one continuously adjustable contact member connected to the shaft member, where the contact member is adapted to be adjusted to a shape to substantially conform to a surface of the heart and has a memory capability to maintain said shape.

In view of the above amendment of claim 216, Applicants respectfully request the Examiner to reconsider and withdraw this ground of rejection. Claim 216 has been amended above to further recite that said at least one continuously adjustable contact member being deformable to a reduced cross-sectional size for delivery through a minimally invasive opening, wherein after passing through the minimally invasive opening, said memory capability facilitating return of said at least one continuously

adjustable contact member to said shape to substantially conform. Support for this amendment can be found, for example at Figs. 21A-25B and the descriptions thereof, and throughout the specification,

It is respectfully submitted that the malleable retractor of DelRrossi et al. does not have a memory capability that facilitates return of the contact members from a deformed state back to a memorized shape to substantially conform to a surface of the heart.

In view of the above amendment and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claim 216 under 35 U.S.C. Section 102(b) as being anticipated by DelRrossi et al., "A New Retractor to Aid in Coronary Artery Surgery", as being no longer appropriate.

**Claim Rejected Under 35 U.S.C. Section 102(b) (Gutnick)**

Claim 215 was rejected under 35 U.S.C. Section 102(b) as being anticipated by Gutnick, U.S. Patent No. 3,913,573. The Examiner asserted that Gutnick shows a device comprising a pair of spaced contact member 36, 38 formed of a continuous length of shape memory alloy (column 6, lines 52-60).

Applicants respectfully traverse this ground of rejection. Initially, Applicants note that the disclosure of Gutnick is to an intrauterine contraceptive device, not to a device which is used in cardiovascular surgery on the beating heart such as is recited in claim 215.

Further, Applicants respectfully submit that Gutnick does not disclose a continuous length of shape memory alloy. The Examiner referred to column 6, lines 52-60 of Gutnick as support for this assertion. However, column 6, lines 52-60 of Gutnick disclose that the intrauterine contraceptive device 10 is formed of a resilient, biologically inert medially (sic, medically) acceptable material having plastic memory. Gutnick describes this material as polyethylene. It is respectfully submitted that polyethylene is clearly not an alloy or a shape memory alloy material as currently recited in claim 215.

In view of the above amendment and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claim 215 under 35 U.S.C. Section 102(b) as being anticipated by Gutnick, U.S. Patent No. 3,913,573, as being no longer appropriate.

**Claim Rejected Under 35 U.S.C. Section 102(b) (Doll)**

Claim 215 was rejected under 35 U.S.C. Section 102(b) as being anticipated by Doll, U.S. Patent

No. 5,078,716. The Examiner asserted that Doll shows a device comprising a shaft and a continuously adjustable wire contact member 126 (column 8, lines 40-43).

Applicants respectfully traverse this ground of rejection. Initially, Applicants note that the disclosure of Doll is to an electrosurgical apparatus, not to a device which is used in cardiovascular surgery on the beating heart to stabilize the beating heart such as is recited in claim 215.

Further, Applicants respectfully submit that Doll does not disclose a pair of spaced contact members including a continuous length of wire of shape memory alloy material. Doll discloses at column 8, lines 45-47, that the wire used is stainless steel. Nor is the wire a continuous length, but rather, two wires are joined by an electrically insulated connector 120, see column 6, lines 61-63.

In view of the above amendment and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claim 215 under 35 U.S.C. Section 102(b) as being anticipated by Doll, U.S. Patent No. 5,078,716, as being inappropriate.

#### **New Claim 217**

New claim 217 depends from claim 215. Support for this amendment can be found, for example at Figs. 21A-22C and the description thereof, and throughout the specification. It is respectfully submitted that claim 217 is patentable over the art of record, and an indication of the allowance of claim 217 is respectfully requested in the next Official Action.

#### **Conclusion**

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

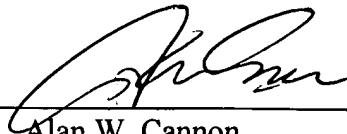
The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-2653, order number GUID-005CON6.

Respectfully submitted,  
LAW OFFICE OF ALAN W. CANNON

Date: \_\_\_\_\_

11/3/08

By: \_\_\_\_\_



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